

**REMARKS**

Claims 1-24 have been examined. Claims 1-16 have been rejected under 35 U.S.C. § 103(a), and the Examiner has objected to claims 17-24.

**I. Objection to the claims**

**A. Claim 17**

The Examiner has objected to claim 17 because the last clause describing the first, second, and third color patterns should replace the first clause describing the first and second color patterns. Applicant has amended the claim as suggested by the Examiner to overcome this ground of the objection. Furthermore, by replacing the first clause of the claim with the last clause of the claim, the phrase "wherein the first pattern has a first pattern color and the second pattern has a second pattern color" becomes redundant. Therefore, Applicant has deleted the above phrase from the claim as shown in the attached Appendix.

Also, Applicant submits that such amendments clearly do not narrow or otherwise alter the scope of claim 17 and are not made in response to any rejection.

The Examiner has also objected to claim 17 because:

Claim 17 should clarify how the parts work together instead of just listing the parts.

Applicant is unsure of the legal or other basis for the Examiner's objection and believe that the claim is not objectionable.

Specifically, claim 17 relates to an electronic device that comprises a button and a lighting device. The button includes a first pattern having a first pattern color, a second pattern

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having a second pattern color, and a third pattern having a third pattern color. Furthermore, the lighting device emits at least a first lighting color and a second lighting color to illuminate the button.

As noted above, the relationship between the first, second, and third patterns and the button and the relationship between the lighting device and the button are clearly described. Thus, contrary to the Examiner's implication, the claim does not recite a list of "dangling" parts having no stated relationship to each other.

In addition, Applicant submits that the claim does in fact state "how the parts work together". Specifically, the claimed device comprises the button and the lighting device, and the lighting device emits a first lighting color and a second lighting color to illuminate the button. Therefore, Applicant is unsure what is unclear about "how the parts work together" and are unsure how the claim could be further amended to clarify "how the parts work together".

Furthermore, Applicant submits that amending the claim to further describe "how the parts work together" would unduly narrow the claim. For example, M.P.E.P. § 2173.04 explains that a broad claim is not indefinite and that a rejection under 35 U.S.C. § 112, second paragraph, should not be used to force the Applicant to narrow the claim:

Breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

Undue breadth of the claim may be addressed under different statutory provisions, depending on the reasons for concluding that the claim is too broad. If the claim is too broad because it does not set forth that which applicants regard as their invention as evidenced by statements outside of the application as filed, a rejection under 35 U.S.C. 112, second paragraph would be appropriate. If the

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claim is too broad because it is not supported by the original description or by an enabling disclosure, a rejection under 35 U.S.C. 112, first paragraph would be appropriate. If the claim is too broad because it reads on the prior art, a rejection under either 35 U.S.C. 102 or 103 would be appropriate.

Analogously, amending the claim to "clarify" how the parts work together would narrow the claim without clarifying its existing limitations.

In light of the discussion above, Applicant requests that the objection to claim 17 be withdrawn.

**B. Claim 18**

Applicant submits that the objection to claim 18 should be withdrawn for reasons that are similar to the reasons presented above in conjunction with claim 17.

**C. Claims 19-24**

The Examiner has objected to claims 19-24 as a result of their dependency upon claims 17 and 18. Since the objection to claims 17 and 18 is overcome, the objection to claims 19-24 is likewise overcome.

**II. Rejection under 35 U.S.C. § 103(a) over JP 58086626 A to Hashizume ("Hashizume") and U.S.P. 6,310,609 to Morgenthaler ("Morgenthaler")**

Claims 1-16 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hashizume and Morgenthaler.

**A. Claim 1**

Applicant submits that claim 1 is patentable over the cited references. For example, claim 1 comprises a button where a plurality of patterns are displayed, and the plurality patterns are colored with a plurality of different colors. Furthermore, the plurality of different colors respectively correspond to a plurality of input modes, and the plurality of input modes respectively correspond to character converting methods.

Figs. 1 and 2 of Hashizume show a key 2 having a blue pattern 7 and a red pattern 8. However, the blue and red patterns 7 and 8 are illuminated based on whether or not a shift key 1 is pressed. Accordingly, the plurality of patterns do not correspond to character converting methods. Since Morgenthaler does not cure the deficient teachings of Hashizume with respect to claim 1, Applicant submits that claim 1 is patentable.

**B. Claims 2 and 3**

Since claims 2 and 3 depend upon claim 1, Applicant submits that they are patentable at least by virtue of their dependency.

**C. Claim 4**

Since claim 4 contains features that are similar to the features recited in claim 1, Applicant submits that it is patentable at least by virtue of its dependency.

**D. Claims 5 and 6**

Since claims 5 and 6 depend upon claim 4, Applicant submits that they are patentable at

least by virtue of their dependency.

**E. Claim 7**

Since claim 7 contains features that are similar to the features recited in claim 1, Applicant submits that it is patentable at least by virtue of its dependency.

**F. Claims 8-16**

Since claims 8-16 depend upon claim 4, Applicant submits that they are patentable at least by virtue of their dependency.

**III. Newly added claims**

Applicant has added new claims 25-30 to provide more varied protection for the present invention.

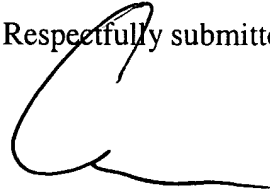
**IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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PATENT TRADEMARK OFFICE

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**APPENDIX**  
**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE CLAIMS:**

**The claims are amended as follows:**

1. (Three times amended) A button for an electronic device, comprising:  
  
a button where a plurality of patterns are displayed on one key top; and  
  
a unit for lighting said button;  
  
wherein said plurality patterns are colored with a plurality of different colors, and said unit includes a plurality of different lighting colors including the same colors as those of said plurality of patterns, and  
  
wherein said unit for lighting comprises a backlight that irradiates said button from a rear side of a display surface of said button,  
  
wherein the plurality of different colors respectively correspond to a plurality of input modes of inputting data to the electronic device, and  
  
wherein the plurality of input modes respectively correspond to character converting methods.
  
4. (Three times amended) A method of controlling lighting of a button in an electronic device, comprising:  
  
providing a button in which a plurality of patterns colored with a plurality of different colors are displayed on one key top;  
  
lighting said button with a plurality of different lighting colors including the same colors

as those of said plurality of patterns so that the lighting color is different from the color of the pattern utilized,

wherein said button is lit from a rear side of a display surface of said button,

wherein the plurality of different colors respectively correspond to a plurality of input modes of inputting data to the electronic device, and

wherein the plurality of input modes respectively correspond to character converting methods.

7. (Twice Amended) An electronic device, comprising:  
a button having at least a first pattern and a second pattern; and  
a lighting device that emits at least a first lighting color and a second lighting color to illuminate the button,

wherein the first pattern has a first pattern color and the second pattern has a second pattern color, and

wherein said lighting device comprises a backlight that illuminates said button from a rear side of a display surface of said button,

wherein the first pattern color and the second pattern color respectively correspond to a plurality of input modes of inputting data to the electronic device, and

wherein the plurality of input modes respectively correspond to character converting methods.

17. (Twice Amended) An electronic device, comprising:



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[a button having at least a first pattern and a second pattern; and]

a button comprising at least a first pattern having a first pattern color, a second pattern having a second pattern color, and a third pattern having a third pattern color; and

a lighting device that emits at least a first lighting color and a second lighting color to illuminate the button.],

wherein the first pattern has a first pattern color and the second pattern has a second pattern color;

wherein said button comprises at least said first pattern having said first pattern color, said second pattern having said second pattern color, and a third pattern having a third pattern color.]

**Claims 25-28 are added as new claims.**